

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number 3894
<p>I hereby certify that this correspondence is being transmitted on the date shown below via facsimile to Commissioner for Patents at the facsimile number indicated below. [37 CFR 1.8(a)]</p> <p>on <u>8/14/06</u></p> <p>Signature <u>Brenda M. Simon</u></p> <p>Facsimile Number <u>571-273-8900</u></p> <p>Typed or printed name <u>Brenda M. Simon, Reg. No. 48,449</u></p>		
<p>Application Number <u>09/428,284</u></p> <p>First Named Inventor <u>Andrew D. Holmes</u></p> <p>Art Unit <u>3628</u></p>		<p>Filed <u>October 27, 1999</u></p> <p>Examiner <u>Timothy M. Harbeck</u></p>
<p>Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>48,449</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p><u>Brenda M. Simon</u> Signature Typed or printed name <u>(650) 335-7198</u> Telephone number <u>8/14/06</u> Date</p>		
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> of <u>1</u> forms is submitted.</p>		

**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW IN U.S. PATENT
APPLICATION NO. 09/428,284 FILED ON OCTOBER 27, 1999**

Pre-appeal brief review is appropriate in this application because the rejections in the July 18, 2006 Final Office Action contain clear deficiencies. Nemzow fails to teach or suggest selecting an exchange rate having a most recent time period among available historical exchange rates having time periods prior to the date of a received financial transaction, as recited in independent claims 1, 10, 15, 19, 22, 24, 26, 29, 32, 35, 44, 49, 53, and 56, and thus *prima facie* obviousness required by MPEP §2143.03 has not been established.

Claims 1-20, 22, 24-33, 35-50, 52-54, and 56 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Nemzow. This rejection is respectfully traversed.

The independent claims 1, 10, 15, 19, 22, 24, 26, 29, 32, 35, 44, 49, 53, and 56 generally recite methods, systems, and computer products for selecting and applying an exchange rate to convert a transaction from a first currency to a second currency. As further claimed, "if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates," that historical exchange rate is automatically selected and applied. As further claimed, "if the date of the received financial transaction does not correspond to a time period of one of the historical exchange rates," a historical exchange rate having a time period prior to the transaction date is selected. In particular, a rate is selected that has the most recent time period among rates whose dates pre-date the transaction. In this manner, the claimed invention is able to handle situations in which no exchange rate corresponds to the date of the transaction.

Nemzow fails to teach such steps. Nemzow merely discloses a currency translation system that translates a first currency value into a target currency value. Nemzow deals with

partial rate information by triangulation of a set of currency translations and by customizing conversion rules. There is no hint or suggestion anywhere in Nemzow of any technique for handling the conditions addressed by the method claimed herein. Specifically, there is no discussion in Nemzow of selecting a historical exchange rate having a most recent time period among available historical exchange rates having time periods prior to the date of the received financial transaction. In fact, Nemzow does not even address any situation in which no historical exchange rate covers the time period of a transaction.

The Examiner's citations to specific portions of Nemzow do not relate in any way to the above-referenced limitation of the claims. Specifically, the Examiner has repeatedly cited paragraph [0051] of Nemzow as allegedly anticipating these limitations. However, paragraph [0051] of Nemzow merely discusses customizing conversion rules in response to user inputs and transaction rules, including matching user inputs against conversion rules, currency conversion rate tables, or a currency conversion rate database. Customization of conversion rules is also discussed, including reconciling currency price differences, handling triangulation discrepancies, computing a balance sheet, or systematic work-in-progress contra-asset category for rounding errors. None of these concepts are in any way related to a determination as to whether the date of a financial transaction corresponds to a time period of a historical exchange rate. Furthermore, none of these concepts are directed to selecting and applying an exchange rate associated with a time period prior to a transaction date.

The Examiner states that the claims "broad language of Nemzow would allow for any user specified conversion and transaction rules.... A user of the Nemzow method could achieve the same result as a user of applicant's invention simply by entering, into the computer system, the above rules." (7/18/06 Office Action, page 3) Such an argument clearly indicates that the

cited reference does not anticipate the claimed invention, since the Examiner explicitly acknowledges that the "same result" could be achieved if the appropriate rules were entered. In making such an argument, the Examiner recognizes that the rules that would mimic the presently claimed invention are not inherent in Nemzow but would have to be provided by some external source that "enter[s], into the computer system, the above rules." Accordingly, the reference does not disclose the claimed limitations.

The reference, in fact, teaches away from the automatic selection of a historical exchange rate. The Examiner contends that the term "optimization" as used in Nemzow should mean "to find to best result according to the user specified rules, not necessarily the maximum." (7/18/06 Office Action, page 20) For the reasons set forth in Applicant's Response G, page 2, paragraph 4 to page 3, paragraph 1, Applicant's maintain that the use of "optimization" in Nemzow means to maximize value of a transaction where data is missing. However, if the Examiner's interpretation of "optimization" were applied, the need for user-created rules would teach away from the automatic selection elements in the independent claims. Under the Examiner's interpretation, to anticipate, Nemzow would require a user to determine how to assign value to a transaction; this is not the same thing as the pre-determined statements set forth in the independent claims:

"if the date of the received financial transaction corresponds to a time period of one of the historical exchange rates, automatically selecting, by the computer system, the historical exchange rate"

"if the date of the received financial transaction does not correspond to a time period of one of the historical exchange rates, automatically selecting, by the computer system, a historical exchange rate having a most recent time period... prior to the date of the received financial transaction"

The above limitations are not "conditional" on user specified rules, as stated by the Examiner, but instead are pre-determined to operate automatically. (7/18/06 Office Action, page 3) The Examiner's interpretation of "optimization" teaches away from the claimed invention, as it requires user intervention for valuation, rather than the automatic selection set forth in the claimed invention.

In discussing "conversion rules," Nemzow does not even contemplate the type of situations and conditions recited in the present claims; Nemzow states, at paragraph [0050], that "conversion rules include the conversion rate and the source of conversion rate data," but does not mention any technique for selecting a conversion rate based on date, to say nothing of selecting a conversion rate having a most recent date among those that predate a transaction.

In the current Office Action, the Examiner appears to no longer rely on paragraph [0052] of Nemzow as allegedly anticipating the following claim language: "automatically selecting, by the computer system, the historical exchange rate." However, to the extent the Examiner now relies on paragraph [0051], which requires user input, there is no anticipation of the "automatically selecting" limitation for the reasons set forth above.

Nowhere in Nemzow is there any teaching that anticipates the specific limitations recited in the claims of the present application. The remaining pending claims depend from the above independent claims, and therefore incorporate the limitations of the independent claims. Accordingly, the arguments presented above apply to the dependent claims as well.

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See MPEP §2143.03. The Examiner contends that because Nemzow allegedly mentions "triangulation or other complex data processing techniques," one of

ordinary skill would have been motivated to use the methods and systems set forth in the claims. (7/18/06 Action, page 20) However, there is no hint or suggestion anywhere in Nemzow as to the use of any technique for selecting a conversion rate based on date, or for selecting a conversion rate having a most recent date among those that predate a transaction. Rather, as discussed above, the Examiner's interpretation of "optimization" as requiring the entry of user-specified rules teaches away from the automatic selection of a conversion rate having a most recent date among those that predate a transaction. Thus, Nemzow does not hint or suggest the specific limitations of the claimed invention necessary for an obviousness rejection under MPEP §2143.01.

Therefore, it is respectfully requested that the final rejections of claims 1-20, 22, 24-33, 35-50, 52-54, and 56 be withdrawn.

Respectfully submitted,
Andrew D. Holmes et al.

Dated: 8/14/06

By: Brenda M. Simon

Brenda M. Simon, Reg. No. 48,449
Fenwick & West LLP
801 California Street
Mountain View, CA 94041
Tel.: (650) 335-7198
Fax: (650) 938-5200